

REMARKS

I. Introduction

In response to the final Office Action dated May 14, 2008, Applicants have incorporated the limitations of claim 3 into claim 1 and cancelled claim 3, without prejudice. Claims 4-6 have been amended to correct improper multiple claim dependency. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection of Claims 1-3 Under 35 U.S.C. § 103

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogino et al. (USP No 4,678,598), Niemiec et al. (USP No. 6,495,498), or Wetzel (USP No. 4,885,107), all in view of Watson et al. (USP No. 4,136,163). Applicants respectfully submit that Ogino, Niemiec, Wetzel and Watson fail to render the pending claims obvious for at least the following reasons.

With regard to the present disclosure, amended claim 1 recites a shampoo or body detergent composition comprising following components (A), (B), (C) and (D); (A) one or more cool and refreshing feeling substances selected from the group which consists of menthol, menthone, camphor, pulegol, isopulegol, cineol, Japanese peppermint oil, peppermint oil, spearmint oil, and eucalyptus oil, (B) one or more cool feeling substances selected from the N-substituted-p-menthane-3-carboxamide derivatives represented by the following general formula (I); wherein R represents an alkyl group or alkenyl group having 1 to 10 carbon atoms, (C) one or more components selected from anionic surfactants, and (D) one or more components selected from water-soluble high-molecular-weight polymers and/or polyhydric alcohols, and wherein the

ratio of the cool and refreshing feeling substance of the component (A) to the cool feeling substance of the component (B) is (30:70) to (99:1) by weight.

The present disclosure describes a shampoo or body detergent composition comprising (A) a cool and refreshing feeling substance such as menthol, (B) cool feeling substance composed of N-substituted-p-menthane carboxamide, (C) anionic surfactant, and (D) water-soluble high-molecular weight polymer and/or polyhydric alcohol. In addition, the ratio of component (A) to component (B) is from 30:70 to 99:1, by weight.

It is admitted that Ogino, Niemiec and Wetzel all fail to teach or disclose the use of the component (B), an N-substituted-p-menthane carboxamide. However, it is alleged that the combination of Watson, which teaches that N-substituted-p-menthane carboxamide compounds have the property of stimulating cold receptors of the nervous system to produce a cold sensation, with any of Ogino, Niemiec and Wetzel discloses the limitations of claim 1 of the present disclosure.

Applicants respectfully disagree with the proposed combination. The present disclosure is characterized by the combination of a cool and refreshing substance such as menthol, and a cool feeling substance composed of N-substituted-p-menthane carboxamide. As is shown in Tables 2, 4, 5, 7, 8, 10 and 12 of the present disclosure, compositions containing a combination of menthol and N-substituted-p-menthane carboxamide exhibited stronger cool and refreshing feeling than compositions that had similar amounts of either only menthol or only N-substituted-p-menthane carboxamide.

For example, Table 3 lists three compositions of shampoo. Example 2 contains 2.5 parts menthol and 0.5 parts N-substituted-p-menthane carboxamide, Comparative Example 2 contains

3 parts menthol and Comparative Example 3 contains 3 parts N-substituted-p-menthane carboxamide. All other components of the shampoos are identical. The subjects who washed their hair with each shampoo and were asked to compare the cooling sensations of each shampoo. As is shown in Tables 4 and 5, the subjects overwhelmingly chose Example 2, even though the total amounts of cooling agents in each shampoo was 3 parts. Thus, the claimed combination, which has both components (A) and (B), exhibits unexpected superior results over compositions having only one or the other component.

In contrast, each of the cited prior art references disclose either only menthol (Ogino, Niemiec and Wetzel) or only N-substituted-p-menthane carboxamide (Watson). There is no teaching or suggestion in any of the cited prior art references to combine two or more cooling agents. Furthermore, there is no suggestion that a combination of the two different cooling substances would achieve a composition which has synergistic cooling effect as described in the present disclosure. Thus, one skilled in the art would not readily combine the two cooling agents, nor would they expect to achieve unexpected superior results as a result of this combination. Accordingly, it is clear that the proposed combination is invalid.

Moreover, Applicants submit that not only would it not have been obvious to combine Watson with Ogino, Niemiec, or Wetzel, but that Watson *teaches against* such a combination. Watson teaches menthol has disadvantages such as strong odor and relative volatility. For example, Watson states in col. 2, lines 3-12 “it is an object of the present invention to provide other compounds having pronounced cooling effect, in many cases far more persistent than that obtained with menthol, without the attendant disadvantages of a strong odor.” As such, Watson teaches away from the use of a compound with a strong odor, such as menthol, in a composition containing a compound of component (B) because both compound types exhibit a cooling effect,

but component (B) compounds do not have the requisite odor. As such, one skilled in the art would not combine Watson with Ogino, Neimiec, or Wetzel based on the teachings of Watson.

Moreover, even if the proposed combination of cited prior art were proper, which it is not, the proposed combination also fails to disclose that the ratio of the cool and refreshing feeling substance of the component (A) to the cool feeling substance of the component (B) is (30:70) to (99:1) by weight. In fact, the Office Action is silent with regard to the claimed ratios, because, as has been discussed above, the cited prior art does not teach or suggest a combination of cooling substances (A) and (B). Accordingly, it is clear that the combination of Watson with Ogino, Neimiec, or Wetzel fails to teach or suggest all of the claim limitations of claim 1 of the present disclosure.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As is clearly shown, Watson, Ogino, Neimiec, and Wetzel do not disclose a shampoo or body detergent composition comprising (A) a cool and refreshing feeling substance such as menthol, and (B) cool feeling substance composed of N-substituted-p-menthane carboxamide, wherein the ratio of component (A) to component (B) is from 30:70 to 99:1, by weight. As such, Watson, Ogino, Neimiec, and Wetzel fail to render claim 1 obvious and accordingly, claim 1 is patentable. Accordingly, Applicants respectfully request that the § 103(a) rejection of claim 1 be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims. *Hartness International Inc. v. Simplimatic Engineering Co.*,

819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having responded to all open issues set forth in the Office Action, it is respectfully submitted that all claims are in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Nathaniel D. McQueen
Registration No. 53,308

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 NDM:kap
Facsimile: 202.756.8087
Date: September 12, 2008

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